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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,977	01/26/2004	Curt D. Seymour	70026970-0011	9301

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EXAMINER
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HOGUE, GARY CHAPMAN

ART UNIT	PAPER NUMBER
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3611

MAIL DATE	DELIVERY MODE
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06/05/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/764,977	<b>Applicant(s)</b> SEYMOUR ET AL.	
	<b>Examiner</b> Gary C. Hoge	<b>Art Unit</b> 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-11 and 13-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 1-7 and 12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species and invention, respectively, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on September 17, 2007.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 18 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The recitation that the groove illustrated in Fig. 8 is “a reinforcement groove to reinforce structural integrity of the frame” is new matter. The Specification is absolutely silent as to the existence, purpose and function of the groove.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 18 is rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. Although it is known that stamping a groove in a sheet of metal will

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improve the rigidity of the sheet, it does not appear that carving a groove in a wooden frame would have the same effect. On the contrary, as shown in Fig. 8, it is clear that the only forces that might be acting on the frame in use would be compressive forces pushing against the back of lip **212**. Therefore, the groove appears to actually weaken the structure right at the point where the forces acting on it would be greatest. Of course, such forces are probably small and it's unlikely that the groove would seriously compromise the integrity of the frame, but it seems equally clear that it could not accomplish the claimed function of reinforcing the frame's structural integrity.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 8-11 and 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Royal (5,383,293) in view of Howell (3,284,113).

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Royal discloses a display system comprising a frame **11** having a lip; a transparent display panel **12** supported within a front side of the frame by the lip, the transparent display panel directly abutting the lip and an interior side surface of the frame (Fig. 3); a single piece spacer **13** positioned within the frame on an opposite side of the panel to the lip, the spacer directly abutting the transparent display panel and the interior side surface of the frame (Fig. 3); a backing **17, 20** positioned on an opposing side of the spacer to the panel, the backing adapted to maintain the spacer and the panel within the frame from a back side of the frame and wherein the backing generally extends across the entire center of the frame to provide an enclosed space within the frame between the panel and the backing. However, the front face of the frame disclosed by Royal appears to be flat, lacking the decorative contour recited in the claim. Howell teaches that it was known in the art to provide a decorative contour on the front face of a picture frame. It would have been obvious to one having ordinary skill in the art at the time the invention was made to the picture frame disclosed by Royal with a decorative contour, as taught by Howell, in order to make the frame more aesthetically pleasing. It is noted that although Howell happens to disclose a contour that meets the claim limitations (see Fig. 4 of Howell), a contour on the front of a picture frame is merely ornamental, and as such would be an obvious matter of artistic design choice no matter how it was claimed.

Regarding claim 9, the backing comprises a matting component **18** and a backing component **20**.

Regarding claim 10, the spacer disclosed by Royal is slightly narrower than the lip, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the spacer similar in width to the lip because such a modification would have

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involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claim 11, the spacer disclosed by Royal has an inner circumference that is smaller than the outer circumference of the lip. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the inner circumference of the spacer similar to the outer circumference of the lip because such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claim 13, see Figs. 10 and 11, and column 8, lines 31-34, of Royal.

Regarding claim 18, although it is not understood how removing material from a frame *reinforces* its structural integrity (the opposite would seem to be the case), nevertheless Howell also discloses a groove, as noted above.

### ***Response to Arguments***

9. Applicant's arguments filed May 18, 2009 have been fully considered but they are not persuasive.

Applicant notes that "Royal is silent regarding a frame having two portions or a groove." It is noted that the instant Specification is equally silent on that point. Although the described contour is illustrated in Fig. 8, the purpose and function of that contour, if any, is not mentioned anywhere in the Specification. Further, as noted above, it appears that the groove would weaken the frame, not reinforce it. However, if Applicant can show that such a groove does in fact strengthen the frame somehow, that principle was either known in the prior art or invented by

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Applicant. If it was known in the prior art, it is not patentable for that reason. If it was invented by Applicant, disclosing it for the first time at this late date is new matter.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C. Hoge whose telephone number is (571) 272-6645. The examiner can normally be reached on 5-4-9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gary C. Hoge/  
Primary Examiner, Art Unit 3611